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10/728,663	12/04/2003	Sean Patrick Nolan	4444.P008	8854

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EXAMINER	
HAIDER, FAWAAD	

ART UNIT	PAPER NUMBER
3627	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/728,663	NOLAN, SEAN PATRICK	
	Examiner	Art Unit	
	FAWAAD HAIDER	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20 and 22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-20 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). The process steps in claims 1-20 are not tied to another statutory class nor do they execute a transformation. Thus, they are non-statutory.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheung et al (2002/0169760) in view of Anderson et al (2004/0093327) and Kim et al (2002/0052925).

Re Claims 1, 22: Cheung discloses identifying target objects on an electronic storefront Web site to which customer traffic is to be targeted (see [0009, 0011]); automatically generating search keywords for the target objects that are identified (see [0010]). Cheung does not disclose initiating a purchase.

However, Anderson discloses initiating purchase of the search keywords from one or more search partners (see [0008, 0063, 0083]). From the teaching of Anderson, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cheung's invention with Anderson's disclosure of initiating a purchase in order to "determine ads relevant to content, and/or combine content with ads determined to be relevant to the content (see Anderson Abstract)."

However, both Anderson and Cheung fail to disclose wherein identifying the target objects includes searching for the target objects located in an electronic catalog separate from the electronic storefront Web site. Meanwhile, Kim discloses wherein identifying the target objects includes searching for the target objects located in an electronic catalog separate from the electronic storefront Web site (see [0042-0043, 0046-0047, 0053]). From the teaching of Kim, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify both Anderson and Cheung

with Kim's disclosure of the identification of target objects in an electronic catalog in order to "resolve the aforementioned shortcomings of current Internet advertising methods... through an e-catalog (see Kim [0042])."

Re Claim 2: Cheung discloses receiving billing and keyword clickthrough data from the one or more search partners; and automatically determining a cost effectiveness of each of the keywords (see [0019, 0024]).

Re Claim 3: Cheung discloses wherein the cost effectiveness of each keyword is determined for each search partner on an individual search partner basis (see [0139]).

Re Claim 4: Cheung discloses wherein the cost effectiveness of each keyword is determined by: calculating an average cost per click (CPC) value based on the billing and keyword clickthrough data received from the one or more search partners; monitoring customer session activities initiated in response to each keyword clickthrough; determining a margin per click (MPC) value comprising an average marginal profit for each customer session activity initiated by a keyword clickthrough for each keyword; and comparing the MPC and CPC values for each keyword (see [0010, 0018, 0023, 0028]).

Re Claim 5: Cheung discloses further comprising automatically deactivating a keyword when it is determined to not be cost effective (see [0125]).

Re Claim 6: Cheung discloses wherein the CPC and MPC values are compared for each keyword at each of the one or more search partners (see [0010, 0018, 0023, 0028]).

Re Claims 7, 18: Anderson discloses wherein purchase, or changing a purchase status, of keywords is automatically initiated by electronically interfacing with the search partner to exchange data identifying the keywords to be purchased (see Figure 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cheung's invention with Anderson's disclosure of interfacing with the search partner in order to "determine ads relevant to content, and/or combine content with ads determined to be relevant to the content (see Anderson Abstract)."

Re Claim 8: Cheung discloses wherein identifying the target objects for which keywords are automatically generated is performed periodically by a target discovery process and comprises identifying any new target objects that have been added to the Web site since the last time the target discovery process was performed (see [0137]).

Re Claim 9: Cheung discloses further comprising: automatically generating formatted search result data corresponding to at least one keyword that is to be purchased; and sending the formatted search result data for said at least one keyword to at least one of the one or more search partners, and including the formatted search result data are in search results produced by said at least one of the one or more search partners in response to searches corresponding to said at least one keyword (see [0006, 0089]).

Re Claim 10: Cheung discloses wherein the formatted search result data is automatically generated by performing operations including: creating a plurality of formatted search result templates; selecting one of the plurality of formatted search result templates applicable for a given keyword and search partner; and filling in the

formatted search result template with information corresponding to a catalog item for which a corresponding keyword was automatically generated (see [0006, 0089]).

Re Claim 11: Cheung discloses wherein the plurality of formatted search result templates includes templates that are particular to at least one of a product, a brand, and a product category (see [0008]).

Re Claim 12: Cheung discloses wherein at least one formatted search result includes a destination URL containing embedded information identifying at least one of a product, brand, or category associated with the corresponding keyword (see [0023, 0086, 0089, 0091-0092]).

Re Claim 13: Cheung discloses wherein at least one formatted search result includes a price corresponding to a target object for which the keyword was automatically generated (see [0014]).

Re Claim 14: Anderson discloses identifying target objects that were previously targeted for customer traffic that are related to catalog items that are either discontinued or currently unavailable; and deactivating the purchase of any keywords corresponding to the target objects that are so identified (see [0086]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cheung's invention with Anderson's disclosure of items that are discontinued or currently unavailable in order to "determine ads relevant to content, and/or combine content with ads determined to be relevant to the content (see Anderson Abstract)."

Re Claim 15: Anderson discloses further comprising: identifying target objects corresponding to items in the electronic catalog that were previously unavailable but are

now available; and reactivating purchase of the keywords corresponding to those target objects (see [0086]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cheung's invention with Anderson's disclosure of items to reactivate discontinued or currently unavailable in order to "determine ads relevant to content, and/or combine content with ads determined to be relevant to the content (see Anderson Abstract)."

Re Claim 16: Cheung discloses wherein the keywords are purchased from a search partner by sending a document to the search partner containing a list of keywords to be purchased along with bids for keywords (see [0014, 0016-0024]).

Re Claim 17: Cheung discloses wherein the document comprises one of a spreadsheet, database table, or an XML (extended markup language) document (see [0028, 0088, 0142]).

Re Claim 19: Cheung discloses further comprising: receiving search result data from a search partner identifying search terms used to retrieve search results containing links to target objects on the electronic storefront Web site; and including those search terms as part of the search keywords that are purchased from the one or more partner sites (see [0010, 0014-0017]).

Re Claim 20: Cheung discloses wherein the target objects include at least one of a product, brand, category, drug, and URL (see [0008, 0023, 0086, 0089]).

Response to Arguments

4. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fawaad Haider whose telephone number is 571-272-7178. The examiner can normally be reached on Monday-Friday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fawaad Haider/

Examiner

Art Unit 3627

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627